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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,131	06/14/2001	Jun Takahashi	03310/017001	8113

22511 7590 09/26/2002

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/881,131

Applicant(s)

TAKAHASHI ET AL.

Examiner

Pamela R. Schwartz

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1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: |

1. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim is confusing and appears to be inconsistent with the specification because it states that the binder, rather than the surfactant includes polyether resin. The only disclosure of the use of a polyether resin appears to be with respect to the surfactant. See the examples.

In addition, use of the term, "main component" is unclear and indefinite because the specification does not define the term and it cannot be determined in what sense the component is a "main" component. Is this based upon weight, volume, function?

Clarification is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipate by, or in the alternative, as obvious under 35 USC 103 over Guistina et al. (5,928,990). The reference discloses a dye image-receiving medium comprising a support and an image-receiving layer including polyester polymer, metal hydrates or salts and surfactants. The surfactants may be polyether units linked through a polyamine group and may be non-ionic (see 5, lines 63 to col. 9, line53). The layer also includes hydrated metals or

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salts which read on inorganic fillers (see col. 5, lines 22-63). See in particular, Receiver Elements 28 and 29 that disclose a polyethylenimine subbing layer that reads on the instantly claimed ink receptive layer. Polyethylenimine is considered to meet applicants' claim requirements to a chemical compound that is a resin having at least one cationic group in its structure. From the quantities of components recited in col. 5, lines 56-62, col. 6, lines 36-41, and col. 9, lines 18-26, the materials may be used in the instantly claimed proportions.

While it is believed that that the reference reads on claims 1-4 and 6-8, it would have been obvious to one of ordinary skill in the thermal dye transfer art to determine proportions and materials from those disclosed by the reference in order to achieve the objects set forth in column 2 of the reference.

3. Claims 1, 2 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (5,919,559).

The reference discloses a recording sheet comprising a substrate and an ink-absorbing coating thereon (see the abstract). The coating may contain one or more resins, including cationic polyvinyl alcohol (see col. 2, line 48 to col. 3, line 22). The layer also contains a nonionic surfactant that may be a polyether (see col. 4, lines 24-55) and the quantities of surfactant appear to be within the instantly claimed range (see col. 4, lines 65 to 5, line 9). The layer may contain other materials as well, including inorganic particles such as silica (see col. 8, lines 7-23 - note that "inorganic" is misspelled on line 7). In addition, the reference discloses use of the water soluble resins and a polyhydric alcohol to form an intermediate layer that has the effect of


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absorbing a water based ink (see col. 8, lines 23-39). Based upon the disclosure of the reference, it would have been obvious to one of ordinary skill in the art to utilize more than one hydrophilic resin in this layer, including cationic polyvinyl alcohol, as suggested by the reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela R. Schwartz whose telephone number is 703-308-2424. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

PRSchwartz
September 25, 2002



PAMELA R. SCHWARTZ
PRIMARY EXAMINER